

Remarks

In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise. Applicant notes at the outset that the Office Action has produced no explanation for the rejection of claim 5.

The final Office Action dated June 20, 2008, lists the following rejections: claims 1-6, 9-12 and 14 stand rejected under 35 U.S.C. § 112(2); and claims 1-6 and 10-12 stand rejected under 35 U.S.C. § 102(b) over Andresen *et al.* (U.S. Patent No. 6,211,693). The Office Action also notes an objection to the drawings.

Applicant notes that claim 5 is indicated as rejected under 35 U.S.C. § 102(b) over Andresen; however, the Office Action has not presented any argument in support thereof. Accordingly, Applicant respectfully submits that there is not a *prima facie* case for a rejection for claim 5 and requests that the rejection be withdrawn or that an explanation be provided and Applicant be afforded a fair opportunity respond thereto.

Applicant respectfully traverses the § 112(2) rejections of claims 1-6, 9-12 and 14 because the Office Action has not provided sufficient analysis thereof and because the claims are clear and in compliance with § 112(2).

Regarding the rejection of claim 1, the Office Action states that the rejection is for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; however, the Office Action identifies “an activation circuit,” “test line” and “a detection circuit for detecting the switching state of said switching circuit” as unclear. M.P.E.P. § 2171 states that an examiner should explain whether the rejection is based on indefiniteness (clarity) or on the failure to claim what applicants regard as their invention. Here the Office Action has identified both rationales, without providing clarification for the rationales. For the purposes of this rejection (including the § 112(2) rejections of claims 2-6, 9-12 and 14), Applicant has assumed that the rejection is based upon an assertion that the claim limitations are unclear.

M.P.E.P. 2173 states that an analysis as to why the phrase(s) used in the claim is “vague and indefinite” should be provided to sustain a § 112(2) rejection. Applicant respectfully submits that the Office Action has merely identified elements and then concluded that they are unclear. The Office Action has not indicated what about the

terms is unclear and instead has presented a conclusory statement and a question about whether the elements are found in the drawings. Applicant notes that because the terms have clear meanings on their face, it is unclear why the Office Action is asking whether the items are shown in the drawings. Should this be the case, Applicant requests clarification and an opportunity to respond before a final office action. Notwithstanding the deficiencies of the rejection, each claim term is clear and definite as detailed in the following discussion.

Regarding claim 1, as indicated in the claims, the activation circuit is used to activate the cascode element. Thus, the activation circuit is a circuit that activates a cascode element. The claims indicate that the test line connects a group of switching elements to provide functionality associated with the electric signal on the test line. The claims indicate that the detection circuit is for detecting a switching state of a switching circuit. Thus, each of the claim elements improperly identified by the Examiner as unclear is explicitly defined by the claim language in structure (*e.g.*, line, elements or circuit) and/or function (*e.g.*, carrying an electrical signal, activating or detection). Applicant respectfully submits that this language is clear on its face, and thus, the rejection is improper. Accordingly, Applicant requests that the rejection be withdrawn.

Regarding claims 8 and 14, Applicant notes that the un-amended claim 14 has explicit antecedent basis for the term “said test point” in claim 11, from which it depends. Applicant notes that the failure to provide explicit antecedent basis for terms does not automatically render a claim indefinite (see M.P.E.P. § 2713.05(3)). Notwithstanding, Applicant has made amendments to the claims, thereby rendering the rejection moot.

Regarding claim 10, Applicant has made an amendment to facilitate prosecution by changing the term “means” to “a detection circuit.” The claim term is clear and definite as it expressly defines a structure (circuit) and a function (detection) associated with various limitations.

Regarding claim 11, Applicant has made an amendment to facilitate prosecution by changing the term “means” to “circuitry.” The claim term defines the structure (circuitry) and function (applying voltages and detecting current as specifically claimed) and the claim term in question is clear and definite.

Notwithstanding, and in an effort to facilitate prosecution, Applicant wishes to help the understanding of the invention. The following examples are merely representative of one or more embodiments of Applicant's invention and do not necessarily limit the claimed invention thereto. An example of the functionality associated with the term "activation circuit" can be found in relation to element 15 of FIG. 6 and the related discussion beginning at paragraph 0013. An example of the functionality associated with the term "test line" can be found in relation to elements 31 and 32 of FIG. 9 and the related discussion beginning at paragraph 0048. An example of the functionality associated with the term "detection circuit" can be found in relation to element 78 and the related discussion beginning at paragraph 0049.

In view of the clarity of the claim terms and the further explanations provided in Applicant's specification, Applicant respectfully submits that the rejection under § 112(2) is improper and should be withdrawn.

The Examiner's objection to the drawings is improper as it relies upon an improper interpretation of the USPTO rules. The sole support for the objections, 37 C.F.R. 1.83(a), is directed to showing claimed features in the figures. MPEP 608.02(e) clarifies how 37 C.F.R. 1.83(a) should be interpreted and applied by an examiner: "The drawings are objected to under 37 CFR 1.83(a) because they fail to show [1] as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing." Although not used in the current Office Action, this language is the suggested paragraph for an examiner that wishes to use a 37 C.F.R. 1.83(a) objection. This is consistent with the definition of a feature: "prominent attribute or aspect of something." Rather than limit the cited rule to prominent aspects of the claims, the Office Action appears to take the position that the figures must provide a near word-for-word correspondence to the claims. Applicant respectfully submits that not all limitations should be interpreted as prominent attributes per 37 CFR. 1.83(a) and that a prominent attribute is consistent with detail that is essential for a proper understanding of the disclosed invention. Moreover, the Office Action's position, if applied to all cases, would ostensibly require that every patent application contain a near word-for-word replication of all language from the claims into the figures.

Applicant's position is also supported by a number of U.S. laws, PTO rules and passages of the MPEP. This support is largely inconsistent with the Examiner's position and will be discussed hereafter.

The Examiner's interpretation of 37 CFR 1.83(a) is contrary to PTO practice, U.S. law and the MPEP. In further support of Applicant's position reference is made to 35 USC §113 and MPEP §601.01(f), which indicate that "applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented." The authority for the PTO to create rules such as 37 C.F.R. 1.83(a) is derived from 35 USC §113. Accordingly, 37 C.F.R. 1.83(a) must be interpreted in light of this law to ensure that the PTO does not exceed the statutory authority granted by the U.S. Congress. In addition, MPEP §601.01(f) indicates that it has been PTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 USC §113. Accordingly, the objection to the drawings is improper and Applicant requests that it be removed.

Notwithstanding, and in an effort to facilitate prosecution, Applicant wishes to help the understanding of the invention. The following examples are merely representative of one or more embodiments of Applicant's invention and do not necessarily limit the claimed invention thereto. An example of the functionality associated with the term "activation circuit" can be found in relation to element 15 of FIG. 6 and the related discussion beginning at paragraph 0013. An example of the functionality associated with the term "test line" can be found in relation to elements 31 and 32 of FIG. 9 and the related discussion beginning at paragraph 0048. An example of the functionality associated with the term "detection circuit" can be found in relation to element 78 and the related discussion beginning at paragraph 0049. The relevant "means" language has been removed by amendment, rendering the associated objections moot.

Applicant respectfully traverses rejection of the claims 1-6 and 10-12 under 35 U.S.C. § 102(b) over the Andresen reference for failing to show correspondence to each claim limitation. Claims 1 and 10 each include limitations directed to selectable voltages on two different test lines. As discussed in Applicant's specification, the Andresen

reference fails to provide the choice of two different voltages between two such test lines (see, e.g., Applicant's specification at paragraph 0054). Accordingly, Applicant respectfully submits that each of the rejections is improper and requests that they be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131

CUSTOMER NO. 65913

By: 

Name: Robert J. Crawford

Reg. No.: 32,122

Shane O. Sondreal

Reg. No.: 60,145

651-686-6633

(NXPS.550PA)